



27 OCT 2006

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In re Application of	:	
YAMAMOTO, et al.	:	
Application No.: 10/565,497	:	DECISION ON PETITIONS
PCT No.: PCT/JP04/10928	:	
Int. Filing Date: 30 July 2004	:	UNDER 37 CFR 1.181
Priority Date: 01 August 2003	:	
Attorney Docket No.: 04703/0203784-USO	:	AND 37 CFR 1.42
For: CASEIN HYDROLYZATE, PROCESS FOR	:	
PRODUCING THE SAME AND USE THEREOF	:	

This decision is in response to applicant's "Request to Withdraw Holding of Notification of Abandonment" filed 12 September 2006 in the United States Patent and Trademark Office (USPTO). The request is being treated as a petition under 37 CFR 1.181. No petition fee is required.

### **BACKGROUND**

On 30 July 2004, applicant filed international application PCT/JP04/10928, which claimed priority of an earlier application filed 01 August 2003. The deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 01 February 2006.

On 20 January 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a First Preliminary Amendment.

On 16 February 2006, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International Application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 30 August 2006, applicant was mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) informing applicant that applicant had failed to respond to the Form PCT/DO/EO/905 mailed 16 February 2006 within the time period set therein and that above-identified application was abandoned as to the United States.

On 12 September 2006, applicant filed the present petition under 37 CFR 1.181 requesting withdrawal of the abandonment arguing that the extendable time period to file response to the Form PCT/DO/EO/905 had not expired accompanied by a response and a petition for a five-month extension of time.

## **DISCUSSION**

### **I. Petition Under 37 CFR 1.181**

Applicant is correct that the maximum extendable expiration date for responding to the Office action mailed 16 February 2006 was 16 September 2006. As applicant has provided a response accompanied by an extension of time payment, a timely response has been filed and it is proper to grant applicant's petition under 37 CFR 1.181 to withdraw the holding of abandonment in this application.

### **II. Request For Status Under 37 CFR 1.42**

Pursuant to 37 CFR 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The declaration filed 12 September 2006 is executed by Hideo Nishimura as the legal heir / representative of the estate of deceased joint inventor Shigo Nishimura. However, the declaration is not in compliance with 37 CFR 1.497 (a)-(b) in that it is unclear whether the declaration is setting forth the residence, post office address and country of citizenship of the deceased inventor, Shigo Nishimura or the legal representative. Under 37 CFR 1.497(b) the information must be provided for both the deceased joint inventor and the legal representative.

## **CONCLUSION**

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

The NOTIFICATION OF ABANDONMENT mailed 30 August 2006 is hereby **VACATED**.

Applicant's petition under 37 CFR 1.42 is **DISMISSED, without prejudice**.

Applicants are hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497 (a)-(b). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.42." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'Derek A. Putonen', written in a cursive style.

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